

**DETAILED ACTION**

**This action is replacing the final action from February 6, 2009**

***Continued Prosecution Application***

In view of the Appeal filed on August 10, 2009, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Dana Ross/

Supervisory Patent Examiner, Art Unit 3725

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 – 3, 6 – 10, and 12 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,808,792 to Weber in view of 2,326,375 to Garrard.

Weber discloses an individualized security document (passport, substrate 8 and column 1 lines 31-33 and column 2 lines 20-21 discloses the substrate being a passport) having a transfer film (figure 2) which is provided with security elements and which has a base film (3) and a decorative layer arrangement (7) having the security elements (12), the decorative layer arrangement having an adhesive 15 on the side remote from the base film. Weber also discloses in column 7 lines 39-44 that the transfer film element (17) be of a size that is the same as the size of the substrate (page of the passport) and the base film being releasably secured to the decorative layer arrangement (figure 2-3 of Weber). Weber further discloses the decorative layer (7 of Weber) having security elements is temporarily connected by means of a release layer (9) to a carrier film (5) which is permanently connected to the base film (3) by means of permanent adhesive (4).

Weber does not however disclose the security document (passport) having a number of pages and a transfer film joined together by means of a fixing or adhesive.

Garrard teaches having a security document (passport) having a number of pages (6) and including transfer film 10 joined by a common fixing (stitches 8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the pages and binding or fixing of Garrard with the passport of Weber for the purpose of securing various amounts of information together in the passport.

Regarding claim 2, Weber modified by Garrard discloses the transfer film provided with security elements is transparent column 3 line 42 of Weber).

Regarding claim 3, Weber modified by Garrard discloses the transfer film comprises paper (column 7 lines 48 and 55 of Weber).

Regarding claim 6, Weber modified by Garrard discloses the decorative layer arrangement is applied in the form of a label to the base film or the carrier film which is permanently connected to the base film (figure 2-3 of Weber).

Regarding claim 7, Weber modified by Garrard discloses the decorative layer arrangement is laminated onto the base film or onto the carrier film which is permanently connected to the base film (figure 2-3 of Weber).

Regarding claim 8, Weber modified by Garrard discloses the decorative layer arrangement is transparent or partially transparent (column 3 line 42 of Weber).

Regarding claim 9, Weber modified by Garrard discloses the base film and/or carrier film provided with position markings (perforations 16 are being considered the position markings).

Regarding claims 10 and 12, Weber modified by Garrard further discloses the wherein at least the base film is provided with a perforation (Figure 1, Items 3, 16 show that the base film 3 is provided with a perforation and Column 6, Lines 31 – 39 disclose the perforations used in separating 17 from the carrier foil 1) for cutting out the base film or the base film with the carrier film permanently attached thereto (Figure 1, Items 3, 16 show that the base film 3 is provided with a perforation and Column 6, Lines 31 – 39 disclose the perforations used in separating 17 from the carrier foil 1) and wherein the perforation extends through the decorative layer arrangement and base film (Figure 1, Items 3, 7, 16).

Regarding Claims 13 and 14, Weber modified by Garrard further discloses wherein the perforation of the transfer film having security elements is provided in coincident relationship with the fixing or adhesive of the security document and the transfer film provided with security elements is fixed by means of the fixing or adhesive in the security document (Column 3, Lines 29 – 39 of Weber teaches that the layer structure of the film can go to intended peripheral edges and Column 6, Lines 31 – 39 of Weber teaches of the perforations for creating individual elements; Page 2, Paragraph 4, Lines 7 - 9 of Garrard teach of perforations created by the fixing to allow separation. One having ordinary skill would know to use that periphery to create elements and use perforations 16 to make individual elements or one element by using that periphery). With respect to Claim 14, the perforations with respect to the fixing and element are discussed in claim 13. The way in which Claim 14 is written it seems the perforations that are claimed are borders on the different lateral sides of the transfer element and

such has been discussed with respect to the fixing and the perforations opposite it to provide the removable element along with the sheet being completely removable as required by Garrard.

Regarding claim 15, in that the base film of Weber modified by Garrard and Malone comprises paper it is inherently capable of supporting security features. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include security features on the base film as suited for the intended use. Furthermore, mere indicia can be considered a security feature so any type of indicia whether printed or drawn can be considered a security feature.

Regarding claim 16, Weber modified by Garrard further discloses the transfer film provided with security elements is of surface dimensions adapted to a page of the security document (column 7 lines 39-44 of Weber).

Regarding claim 17, Weber modified by Garrard further discloses wherein the transfer film is provided with security elements of surface dimensions adapted to a double page of the security document. It would have been an obvious matter of design choice to size the transfer film as claimed since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding Claims 18 and 19, Weber modified by Garrard further discloses wherein the transfer film includes a means for separating a portion of the base film away from

the security document (Column 5, Lines 66 - 67 --> Column 6, Lines 1 - 2 teaches of the release and perforation 16 allows for sections to be separated [Weber]; also please review the rejection of Claims 13 and 14 with respect to the sheet on which the transfer elements are created on) wherein at least another portion of the base film remains on the security document after the portion of the base film is separated away from the security document along the separation means (Figure 1 of Weber shows that because of perforation 16, the portions next to it that are not cut will remain intact).

Regarding Claim 20, Weber modified by Garrard further discloses wherein the separation means is included on at least one of the base film and the decorative layer arrangement (Perforation 16 of Weber goes through all of the named layers; Column 5, Lines 66 - 67 → Column 6, Lines 1 – 2 and Figure 1 of Weber shows the release 2 is included on the base film).

Regarding Claim 22 – 24, please review the rejection of Claims 18 - 20

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber in view of Garrard and further in view of 5,103,583 to VanErmen.

Weber modified by Garrard discloses most elements of the claims but for the base film having a window or opening.

VanErmen teaches having a label system having a base film (backing 12) with a window. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the window of VanErmen with the base film of Weber modified by Garrard for the purpose of viewing indicia or allowing for the addition of indicia on the underlying surface. It is noted that Weber discloses the transfer film as

being label-like in its arrangement (column 6 lines 28-31 and column 7 lines 36-44 of Weber); therefore the combination with VanErmen would have been obvious to one having ordinary skill in the art.

Regarding claim 21, see rejection of claim 1 above.

### ***Allowable Subject Matter***

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of Weber teaches against this as the sheet providing the transfer films is created to have a series of cuts in order to create multiple peelable elements (Column 3, Lines 29 – 39 teaches of the elements being used on a sheet and Column 6, Lines 31 – 39 teach about the perforations being used to separate the elements. Providing a perforation away from decorative layer and only in the base film would not help create any of these individual elements as taught by Weber).

### ***Response to Arguments***

Applicant's arguments with respect to the pending claim have been considered but are moot in view of the new ground(s) of rejection. With respect to the use of Malone, the current Examiner feels that the combination was improper as it was not an appropriate combination with respect to Garrard and the sheet being completely removable (as pointed out by Applicant in the Appeal Brief). Furthermore, the current Examiner does not feel Malone is appropriate with respect to teachings of the

perforations and separation in the transfer element. Also there is no reason to only provide a perforation in the base film since the transfer foil of Weber would not operate properly.

With respect to the combination of Weber and Garrard the prior art of Garrard merely shows that transfer films in passport security documents are well known. The combination is not replacing the transfer film of Garrard with Weber but providing the pages and bindings of passport as taught by Garrard for the passport of Weber (Column 1, Lines 31 – 33 of Weber teaches of the passport and Column 2, Lines 29 – 31 of Weber teaches of use in documents). Garrard is merely showing a means in which to present the transfer films in a passport.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./  
Examiner, Art Unit 3725  
January 12, 2010

/Dana Ross/  
Supervisory Patent Examiner, Art Unit 3725